

REMARKS

The Non-Final Office Action mailed July 7, 2009 has been received and carefully considered. Claims 1-69 are pending in the application. Claims 1-69 stand rejected. No new matter has been added. Entry of the amendments to the claims and reconsideration of the outstanding rejections in the present application are requested based on the following remarks¹.

Claim Objections

On page 2 of the Office Action, claims 1, 25, 44, 50, 59, 60, and 61 are objected to because the lines are crowded too closely together. Applicant notes that the claims were doubled spaced in accordance with 37 C.F.R. §1.52(b) and complied with 37 C.F.R. §1.75 with regards to format. Applicant notes that §1.75(i) reads that “each element or step of the claim *should* be indented” (emphasis added). The language of this rule is not mandatory. However, to make reading the claims easier and to address the Examiner’s objections, Applicant added line breaks and indentions within the claims to separate the individual elements to make reading easier.

Rejection of Claims 44-58 under 35 U.S.C. § 101

On pages 2-3 of the Office Action, claims 44-58 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The claims are alleged to not being tied to another statutory class of subject matter and as not physically transforming the underlying subject matter. Applicant respectfully traverses this rejection.

¹ As Applicant’s remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicant’s silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Claim 44 recites, *inter alia*, “communicatively coupling a remote station to a user station; providing a database at the remote station; storing in the database ones of the uniquely identifying codes that have been previously received from one or more user stations.” Applicant submits that the method recited by claim 44 is tied to a particular machine. Claim 44 provides a positive recitation of computer hardware that represents a particular apparatus, namely a “remote station” and “a user station.” Furthermore, these stations are “communicatively coupled” and the “remote station” has a “database” present. Therefore, claim 44 recites statutory subject matter and Applicant respectfully requests the withdrawal of the § 101 rejection.

However, despite disagreeing with this rejection, Applicant has amended claim 44. Support for the amendments can be found at least on pages 17-18 of the present application. Applicant submits that this amendment overcomes the present § 101 rejection and Applicant respectfully requests the withdrawal thereof.

Rejection of Claims 23 and 43 under 35 U.S.C. 103(a)

Claims 1-17, 24-25, 28-38, 44-50, 54-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of U.S. Patent No. 4,949,256 to Humble (“Humble”). Applicant respectfully traverses these rejections.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An “expansive and

flexible approach” should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Independent claim 1, as amended, recites “wherein each one of each group bears a code that uniquely identifies each one in the group and each one in the group is substantially identical in type.” Support for the amendment may be found, for example, at least on page 13, lines 3-5 of the present application. Applicant first notes that the Examiner has failed to provide a citation in either Walker or Humble where this element of the claim may be found, leaving the Applicants to speculate on the nature of the rejection. Applicants respectfully submit that Walker, either alone or in combination, fails to disclose the recited element. Walker discloses a “product database 28” which contains three records including “an item code field 62.” See col. 5, lines 9-14. Walker further discloses that “[p]roduct database 28 is used to track data relating to items in the gift program” and “[i]tem code 62 is an index number assigned by the database manager.” Col. 5, lines 13-16. Walker fails to disclose that *each one of each group bears a code that uniquely identifies each one in the group and each one in the group is substantially identical in type*. Accordingly, Walker fails to render at least this element obvious.

The addition of Humble fails to cure this deficiency. Humble discloses a “coupon validation network.” See Abstract. While Humble discloses databases to store coupon

information, see, e.g., col. 5, lines 6-17, Humble fails to disclose any arrangement of the database. Humble discloses that customer are able “to query their coupon accounts and to obtain special shopping lists.” Col. 7, lines 37-39. Humble discloses that “[t]he list might be arranged by product category.” Col. 7, lines 39-40. However, Humble fails to disclose that *each one of the group is substantially identical in type*.

Applicant respectfully submits that the Examiner has failed to present a *prima facie* case of obviousness and that the obviousness rejection of claim 1 be withdrawn.

Rejected claims 2-17 and 24 depend from independent claim 1 and thus incorporate the elements of independent claim 1, and are allowable for at least the reasons set forth above. Moreover, these claims recite additional features that are not disclosed or suggested by the cited reference.

Independent claims 25, 44, 50, 59, and 60, although differing in scope, recite similar elements to independent claim 1, and are therefore allowable for at least the reasons given for independent claim 1 above. Furthermore, claims 25, 44, 50, 59, and 60 have been amended in a similar manner to independent claim 1. Support for the amendments to claims 25, 50, and 60 may be found, for example, at least on page 22, lines 5-8 of the present application.

Dependent claims 28-38, 44-49, and 54-58 depend from independent claims 25, 44, and 50, and thus incorporate all the elements of the respective independent claims and are therefore allowable for at least the reasons set forth above.

Rejection of Claims 18-22, 26-27, 39-42, and 51-53 under 35 U.S.C. 103(a)

Claims 18-22, 26-27, 39-42, and 51-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Humble and in further view of Official Notice. Applicant respectfully traverses these rejections.

Claims 18-22, 26-27, 39-42, and 51-53 are dependent upon at least one of independent claims 1, 25, 44, and 50, and thus inherently incorporate all of the limitations of the independent claims. Also, the secondary references (i.e., Humble and Official Notice) fail to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1, 25, 44, and 50. Accordingly, claims 18-22, 26-27, 39-42, and 51-53 are allowable over the combination of the secondary references with the primary reference at least by virtue of their dependency on at least one of independent claims 1, 25, 44, and 50.

Rejection of Claims 23 and 43 under 35 U.S.C. 103(a)

Claims 23 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Humble and in further view of U.S. Patent No. 6,321,211 to Dodd (“Dodd”). Applicant respectfully traverses these rejections.

Claims 23 and 43 are dependent upon independent claims 1 and 25, respectively, and thus inherently incorporate all of the limitations of the independent claims. Also, the secondary references (i.e., Humble and Dodd) fail to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1 and 25. Accordingly, claims 23 and 43 are allowable over the combination of the secondary references with the primary reference at least by virtue of their dependency on independent claims 1 and 25.

Rejection of Claims 61-69 under 35 U.S.C. § 102(e)

Claims 61-69 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,138,106 (“Walker”). This rejection is hereby respectfully traversed.

In order to maintain an anticipatory rejection under 35 U.S.C. § 102, a reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (a claim is anticipated only if each and every element as

set forth in the claim is found, either expressly or inherently described, in a single prior art reference). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 (quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The Federal Circuit reiterated the standard for anticipation under 35 U.S.C. §102 in Net Moneyin v. Verisign, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008), stating:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Furthermore, a “reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” Sanofi-Synthelabo v. Apotex, Inc., 89 USPQ2d 1370, 1375 (Fed. Cir. 2008) (emphasis and alterations in original) (quoting In re Arkley, 172 USPQ 524 (CCPA 1972)).

Independent claim 61 recites the element of “wherein said at least one product is transacted in exchange for multiple resource types included in said account.” Walker discloses the use of “gift certificates, purchasable by a buyer, represent a value stored in a database.” Abstract. Applicant submits that Walker’s stored value gift certificates do not represent *multiple resource types included in said account* as defined by the claimed inventions.

Furthermore, Applicant has amended claim 61 to recite, *inter alia*, “wherein further the user can transfer value from the at least one account associated with the user to at least one account belonging to a second user.” Support for this amendment may be found in the present application, for example, at least on page 29, lines 11-13. Applicant submits that Walker fails to disclose this element, either alone or in combination with the other cited art.

Therefore, Applicant submits that Walker fails to anticipate claim 61, for at least these reasons, and Applicant respectfully requests the withdrawal of the anticipation rejection of independent claim 61.

Dependent claims 62-69 depend from independent claim 61, and is allowable for at least the reasons set forth above.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, and all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

Date:

9/30/09



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